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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,768	12/04/2001	Venkatesan Srinivasan	E0358/7002	3021

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EXAMINER

GREIMEL, JOCELYN

ART UNIT	PAPER NUMBER
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3693

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,768

Applicant(s)

SRINIVASAN ET AL.

Examiner

Jocelyn Greimel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/4/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/4/02, 1/31/02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Applicant's application of December 04, 2001, which claims the benefit of 60/251,077 filed December 04, 2000. Claims 1-49 are pending and are presented to be examined upon their merits. Claims 1, 15, 23, 39, 48 and 49 are independent claims.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 39 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). Claim 39 involves providing financing services but merely describes defining values and defining packets. The act of providing the services is not disclosed. The claim does not set forth any steps involved in the method/process of providing the service, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 15 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Examiner finds the term "purpose" to be broad and vague. However, Applicant discloses in the Specification the term to mean one of a sort of financial transactions. For examination purposes, Examiner will treat the term "purpose" to mean one a varied group of financial transactions.

5. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are as follows: Claim 15 relates to communicating in relation to financial services but merely describes providing, defining, determining and structuring a message. The communication of the message that is developed is not disclosed.

6. Claim 39 involves providing financing services but merely describes defining values and defining packets. The act of providing the services is not disclosed. The claim does not set forth any steps involved in the method/process of providing the service, it is unclear what method/process applicant is intending to encompass. A claim

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is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

7. Claim 39 is also rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. **Claims 1-49 are rejected under 35 U.S.C. 102(a) as being anticipated by Samra et al. (US Patent No. 6,970,830, hereinafter Samra).** In reference to claims 1, 15, 23, 39, 46-49, Samra a method, system and computer medium that discloses:

- providing definitions for a plurality of types of information packets, each information packet including at least one variable (col. 2, lines 5-23);
- defining a plurality of values and a purpose for communication between devices in a financing services network (col. 2, lines 5-67; col. 3, lines 1-25);

- determining a set and a subset of information packets that are to be used to structure the content of a message sent between the devices based on the defined purpose (col. 2, lines 11-67; col. 3, lines 1-67; col. 4, lines 21-55);
- defining a value for at least one variable for at least one information packet in the set of information packets (col. 2, lines 11-67; col. 3, lines 1-67; col. 4, lines 21-55);
- sending the message including the set of information packets and the defined value for the at least one variable (col. 2, lines 11-67; col. 3, lines 1-67; col. 4, lines 21-55);
- structuring a message for transmission between the devices using the set of information packets (col. 2, lines 11-67; col. 3, lines 1-67; col. 4, lines 21-55);
- a user interface that receives input and defines a purpose for the communication that structures the communication (col. 4, lines 21-55; figure 1);
- defining a plurality of values for the levels in a communication interface hierarchy based on user input indicating a financing service to be accessed within a financing network, the communications interface hierarchy including a plurality of levels (col. 4, lines 21-55; figure 1);
- defining a set of information packets to be included in electronic messages related to the financing service based on the values for levels in the communications interface hierarchy (col. 4, lines 21-55; figure 1);

- receiving a communication from an external computer which is based on the interface and sending a communication to an external computer which is based on the interface (col. 4, lines 21-55; figures 1 and 2).

10. In reference to claims 2-14, 16-19 and 24-30, Samra discloses a method wherein: the information packets support a plurality of different communication purposes; the different communication purposes include a variety of financial transactions; the information packets have a set of variables; all messages have a common heading; definitions of the information packets include consumer information; a set of values define the purpose; the information packet corresponds to the purpose of the communication; there is a purpose hierarchy; the hierarchy has levels; the hierarchy is based on the transaction and the information packet; the transaction is associated with a hierarchy; and the values of the hierarchy include using input from the user to define the values (col. 2, lines 11-67; col. 3, lines 1-67).

11. In reference to claims 20-22, Samra discloses a transaction comprising an operation with associated information packets; the transaction is associated with a hierarchy; and the values of the hierarchy include using input from the user to define the values (col. 2, lines 11-67; col. 3, lines 1-67).

12. In reference to claims 31-38, Samra discloses a network interface: that selects a set of information packets that correspond to values for a plurality of levels in hierarchy

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to define the communication; the user defines the purpose of the communication through values of the hierarchy; the hierarchy has levels; determines at least one transaction to be executed based on the values of the hierarchy; the network interface determines at least one operation that is associated with at least one transaction; the network interface defines a set of information packets associated with the hierarchy; wherein the system is an external computer system that communicates within the network with an adapted network interface; and wherein the network interface is adapted to accommodate interactive communication between the network and at least one external computer system before a decision to accept or decline a requested financial service has been made (col. 2, lines 11-67; col. 3, lines 1-67).

13. In reference to claims 40-47, Samra discloses a network interface that defines values for levels in a hierarchy; the hierarchy has levels; the hierarchy is based on the transaction and the information packet; the information packet corresponds to the operations level; the information packets are dependent on the hierarchy; and the information packets are sent and received in messages (col. 4, lines 21-55; figure 1).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn Greimel whose telephone number is (571) 272-3734. The examiner can normally be reached Monday - Friday 8:30 AM - 4:30 PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, James Trammell can be reached at (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jocelyn Greimel
Examiner, Art Unit 3693
August 28, 2006


ELLA COLBERT
PRIMARY EXAMINER